

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	
Onur Celebioglu et al	§	
	§	Confirmation No.: 6593
Serial No. 09/912,903	§	
	§	Group Art Unit: 2616
Filed: July 25, 2001	§	
	§	Examiner: Phunkulh, Bob A.
For: SYSTEM AND METHOD FOR	§	
DETECTING AND INDICATING	§	
COMMUNICATION PROTOCOLS	§	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Responsive to the Final Office Action, dated December 12, 2006, and the Advisory Action dated February 12, 2007, please consider the following remarks in connection with the pre-appeal brief request for review. Review of the final rejection is requested for the following reasons.

1. The rejection of claims 1-11 and 24-29 is not supported by a *prima facie* case of obviousness for claims 1-11 and 24-29.

Claims 1-11 and 24-29 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Perrin et al (U.S. 2002/0161924) (Perrin). A *prima facie* case of obviousness is missing, however, at least because there is no support for an obviousness rejection of the claimed subject matter as a whole because Perrin fails to disclose each element of the claims or suggest the missing elements.

The claims rejected and pending are 1-11 and 24-29.

Perrin discloses a router with a plurality of LED's that detect network traffic and router communication, but does not disclose a plurality of sets of indicators associated with a connection interface that are activated in response to detected protocols associated with the interface, each set of indicators being associated with a different protocol such that in response to a packet being communicated, one or more protocols associated with the packet is detected and that detected protocol activates a respective indicator, as required by independent claims 1 and 10. Perrin discloses a router 10 with ports 28-49 and a plurality of LED's 48-57 "which operate to provide the user of the router 10 with certain information regarding the operation and

performance of the router” (Paragraph [0044], lines 1-4). Perrin further discloses that such “information regarding operation and performance of the router” includes “...a visual indication of network activity through the router. The LEDs provide a bar graph display where more energized LEDs indicate more network traffic through the router. When two routers are paired together to form a high-availability router, one LED acts as a ‘heart beat’ to provide a visual indication that each router is communicating with the other. The remaining five LEDs continue to act as a bar graph of network traffic.” (Paragraph [0045]). The LEDs disclosed by Perrin function to indicate the amount of network activity through the router and whether routers are communicating with each other. There is no teaching or suggestion in Perrin that any of the LEDs 48-57 are activated in response to detected protocols associated with packets received through any of the ports 28-49. Furthermore, Perrin does not disclose sets of indicators associated with a connection interface and in different platform layers such that each indicator in the set is associated with a different protocol operating within its respective layer. The LEDs 48-57 disclosed by Perrin simply detect network traffic and router communication.

The Examiner argues that “...Perrin discloses a plurality of LEDs 48-57 which operate to provide the user of the router 10 with certain information regarding the operation and performance of the router 10. The precise number of LEDs and their placement on the router 10 are not limiting to the present invention, and more or less LEDs or other optical and/or audible devices may be employed to provide the user with more or less operational or performance feedback. However, in this embodiment the six LEDs 48-57 do perform certain useful functions (see para. [0044]). Also, Perrin further discloses the router supports a plurality of protocols (see para. [0043])”.

Paragraphs [0043] and [0044] of Perrin disclose nothing about detecting protocols. Paragraph [0043] is a discussion of ports on the router, including port capacity and type, and includes the statement “In fact, any PCI based network interface card may be used in the ports, e.g. cards to interface to T-1, OC-*, token ring, ARCNET, V0.35, FDDI, ATM, DSL, ISDN, or other devices...” Paragraph [0044] is a discussion of the LEDs 48-57 and includes the statements “a plurality of LEDs which operate to provide the user of the router 10 with certain information regarding the operation and performance of the router 10. The precise number of LEDs and their placement on the router 10 are not limiting to the present invention, and more or less LEDs or other optical and/or audible devices may be employed to provide the user with more or less operational or performance feedback.” Applicants respectfully submit that the Examiner is in error in arguing that the two statements above in paragraphs [0043] and [0044] of Perrin are sufficient to support an obviousness rejection of independent claims 1 and 10.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the reference does not disclose a plurality of sets of indicators associated with a connection interface that are activated in response to detected protocols associated with the interface, each set of indicators being associated with a different protocol such that in response to a packet being communicated, one or more protocols associated with the packet is detected and that detected protocol activates a respective indicator, as required by independent claims 1 and 10.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on the reference, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the reference cannot be applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the reference does not teach, or even suggest, the desirability of the combination because it does not teach nor suggest a plurality of sets of indicators associated with a connection interface that are activated in response to detected protocols associated with the interface, each set of indicators being associated with a different protocol such that in response

to a packet being communicated, one or more protocols associated with the packet is detected and that detected protocol activates a respective indicator, as required by independent claims 1 and 10.

Thus, the reference does not provide any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for using the reference to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

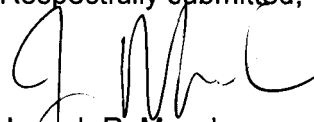
The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

This rejection relies on a reference that does not teach or suggest the claimed combination.

Other reasons for the patentability of claims 1-11 and 24-29 have been previously presented and will be maintained should the filing of an appeal brief become necessary.

Respectfully submitted,



Joseph R. Mencher
Registration No. 56,822

Dated: 3-6-07
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 214/200-0853
ipdocketing@haynesboone.com

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office, via EFS-Web, on the date indicated below:

on

Date

March 6, 2007



Susan C. Lien